

REMARKS/ARGUMENTS

Since the present amendment raises no new issues for consideration and, in any event, places the present application in better condition for consideration on appeal, it is respectfully requested that this amendment be entered under 37 CFR 1.116 in response to the last Office Action dated December 30, 2009, which made final rejections as to the pending claims. Applicant respectfully requests reconsideration of the Examiner's position based on the amendments to the claims and the following remarks.

Claim Status

Claims 1-11 and 50-53 are pending. Claims 1 has been amended to further define the process for waterproofing a semimanufactured product.

The Invention

The presently claimed invention discloses a process for waterproofing goods such as footwear, clothing, items and accessories as the products are manufactured by adding a layer of material.

See Exhibit 1 attached hereto in which seven (7) explanatory figures show the steps of the presently claimed process. Figure 1 shows the membrane in a two-dimensional shape. Figure 2 shows the two halves of the membrane being folded together. Figure 3 shows the membrane in a folded state. Figure 4 shows the ends of each half of the folded membrane being superimposed on each other. Figure 4bis shows the three-dimensional sheath obtained from the membrane shown in Figure 1. Figure 5 shows the three dimensional sheath being arranged onto a reversed shoe upper. Finally, Figure 6 shows the three dimensional sheath in a final position on the reversed shoe upper. The sheath of these figures differs from sheath (18) in Figure 3 of the application as filed in that the sealing strip, obtained by welding two superimposed edges, is arranged on the front portion of the same sheath, while the strip (25) in Figure 3 is arranged on the rear portion of the sheath. The claims however are not limited to the position of the sealing strip.

Claim Rejections – 35 U.S.C. § 103

Claims 1-11 and 51-53 had been rejected under 35 U.S.C. § 103(a) as being unpatentable over Morlacchi, *et al.* (International Application WO 02/11571) (hereinafter Morlacchi) in view of Polegato (U.S. Patent No. 5,983,524) (hereinafter Polegato).

The presently claimed invention is distinguishable from Morlacchi in view Polegato because this combination does not disclose all of the process steps of the presently claimed invention.

Applicant respectfully disagrees with the Examiner that Morlacchi teaches that the waterproof sheets are folded and flattened if they extend beyond the side of the semimanufactured product. Morlacchi explains at lines 8-10 of page 2, line 11 of page 3, and in claim 3 at line 20 of page 7, that only the semimanufactured product (1) is folded and flattened, not the sheets (5).

Moreover, unlike the presently claimed invention, the sheets (5) of Morlacchi are never folded such that two portions of a sheet are bent so as to be superimposed them upon themselves. Either sheet (5) of Morlacchi simply follows the surface of one half of the semimanufactured product (1), when pressed in a sandwich-like manner as shown in Figures 2 to 8. Unlike the presently claimed invention as shown in Exhibit 1, no portion of a sheet of the semi-permeable membrane is in contact with another portion of the same sheet of semi-permeable membrane during and after the process disclosed in Morlacchi.

Additionally, the Examiner stated that Morlacchi does not teach that the semi-permeable membrane is cut, folded or welded together by superimposing two edges and turned to Polegato. Polegato discloses a membrane (109) which has an existing three-dimensional (pseudo conical) shape. Unlike the presently claimed invention as shown in the figures of Exhibit 1, the membrane of Polegato does not have edges which are folded, superimposed and welded to obtain the three-dimensional shape. The membrane (109) of Polegato is monolithic (i.e., formed without welded or superimposed portions) and, contrary to the presently claimed invention, does not have any edge welded to form at least one strip and to obtain a three-dimensional conformation from a two-dimensional membrane. The presence of such a strip, if any, should be visible at least in one figure of Polegato, which instead shows only monolithic sheaths.

Although the lower edge of the membrane (109) of Polegato is bent inwards, this step is carried out only after the same membrane is already applied to the semimanufactured product (101) and for a different purpose, namely for the application of the membrane (111) under the

insole (107), which is already a phase of the manufacture of the final product (conceptually different from the waterproofing of a semimanufactured product). However, as noted above, unlike the presently claimed invention, membrane of Polegato does not have edges which are folded, superimposed and welded to obtain the three-dimensional shape.

Applicant notes that Polegato, by disclosing a monolithic three-dimensional sheath applied inside a shoe upper, leads a person of ordinary skill in the art away from any solution in which the sheath is obtained by cutting, folding and welding a two-dimensional membrane, as in the presently claimed invention. The monolithic three-dimensional sheath of Polegato is harder to manufacture and is not as easily adaptable for use with different sizes of shoes as is the sheath claimed in the presently claimed invention.

Therefore, neither Morlacchi nor Polegato independently or in combination disclose or suggest a process for waterproofing a semimanufactured product, in particular a shoe upper, in which a two-dimensional waterproofing membrane is cut, folded, partially superimposed and welded to form at least one strip and to obtain a three-dimensional sheath, which is applied to the semimanufactured product only during subsequent process steps. Since Polegato already discloses a three-dimensional sheath, Polegato could not be combined with Morlacchi. Morlacchi discloses a process to form a three-dimensional shape from a two-dimensional shape. One of ordinary skill in the art would not combine the existing three-dimensional sheath of Polegato with the two-dimensional water-proofing membrane of Morlacchi to form a three-dimensional sheath.

Thus, claims 1, 52 and 53 are distinguishable from and patentable over Morlacchi in view of Polegato since Morlacchi in view of Polegato does not disclose all of the process steps disclosed in claims 1, 52 and 53 of the presently claimed invention.

Claims 2-11 are ultimately dependent upon claim 1. Therefore, since claim 1 is patentable over Morlacchi in view of Polegato, claims 2-11 are also patentable over Morlacchi in view of Polegato.

No new matter has been added. Reconsideration and removal of the rejections is therefore proper and earnestly solicited.

Fees

This response is being filed within the shortened period for response. Thus, no fees are believed to be required. If, on the other hand, it is determined that any further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

Conclusion

In view of the actions taken and arguments presented, it is respectfully submitted that each of the matters raised by the Examiner has been addressed by the present amendment and that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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